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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,822	02/22/2002	Kuniyoshi Maruyama	597/1/005	9540

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EXAMINER

KYLE, MICHAEL J

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,822

Applicant(s)

MARUYAMA, KUNIYOSHI

Examiner

Michael J Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 5 is objected to because it is unclear of the “person whose address is not open to the public” is the same as the “posted person”.
2. Claim 5 is objected to because it is not clear if the “said person” in line 3 of the claim is the same as the ““person whose address is not open to the public”.
3. Claim 5 is objected because line 3 of the claim reads “posted said person”. Examiner believes this should read --said posted person-- or --a posted person--.
4. Claim 6 is objected to because it is unclear of the “person whose address is not open to the public” is the same as “the posted person”.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima (U.S. Patent Application Publication 2003/0074265) in view of Ewing (U.S. Patent Application Publication 2002/0095928).
7. Oshima discloses a managing and charging system on an internet where a person (page 9, paragraph [0131]) whose address is not open to the public can post a message, comprising a storage unit (paragraph [0025]) for storing a mail address, application receiving means (second

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terminal 90, described in the abstract, lines 16-18) for receiving an application by a visitor (“giver”), confirmation means responsive to the application receiving means for confirming to the visitor, the receiver of the gift and visitor’s consent to payment (page 7, paragraph [0088]), and payment processing means for processing and confirming payment completion (page 7, paragraph [0088]). Oshima does not explicitly disclose means responsive to the payment completion for notifying the visitor of the mail address of the posted person.

8. Ewing teaches a blind gift system whereby one user can send a gift, or gifts, to another anonymous user. In one situation, a member’s true full name and address information may be transmitted in response to a gift delivery (paragraph [0028]). This allows the users to communicate freely without having to use the gift system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Oshima as taught by Ewing, in order to allow communication outside of the electronic system. The invention resulting from this combination would then send the address of the person whose address is not known to the public to the visitor in response to the visitor sending a gift.

9. With respect to claim 2, Oshima discloses the system to includes means to initiate delivery of the gift to the posted person by using physical distribution means following confirmation of the payment completion (page 7, paragraph [0088]). The examiner asserts that physical (non-electronic) gift will be delivered using physical distribution means.

10. With respect to claim 6, Oshima discloses a method for operating a managing and charging system on an internet where a person (page 9, paragraph [0131]) whose address is not open to the public can post a message, comprising storing a mail address (paragraph [0025]) of a posted person, receiving, at the system, an application by a visitor (“giver”), utilizing the system

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for confirming to the visitor the receiver of the gift and visitor's consent to payment (page 7, paragraph [0088]), and utilizing payment processing means at the system for processing and confirming payment completion (page 7, paragraph [0088]). Oshima does not explicitly disclose utilizing the system for notifying the visitor of the mail address of the posted person.

11. Ewing teaches a blind gift system whereby one user can send a gift, or gifts, to another anonymous user. In one situation, the system is utilized to notify a user of a member's true full name and address information in response to a gift delivery (paragraph [0028]). This allows the users to communicate freely without having to use the gift system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Oshima as taught by Ewing, in order to allow communication outside of the electronic system. The invention resulting from this combination would then send the address of the person whose address is not known to the public to the visitor in response to the visitor sending a gift.

12. With respect to claim 7, Oshima discloses the system to includes means to initiate delivery of the gift to the posted person by using physical distribution means following confirmation of the payment completion (page 7, paragraph [0088]). The examiner asserts that physical (non-electronic) gift will be delivered using physical distribution means.

Response to Arguments

13. Applicant's arguments with respect to claims 5 and 6 have been considered but are moot in view of the new ground(s) of rejection. All claims now stand rejected under the combination of Oshima in view of Ewing. In the originally filed claims, applicant claimed "a step to notify a mail address of said posted person" (claim 1), but did not specify who or what was to be notified

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of the address. In the amended claims filed on November 24, 2003, applicant modified this limitation to include that visitor is notified of the mail address (last 2 lines of claim 5). This change in the claims necessitated the new grounds of rejection.

14. Applicant argues that Oshima is concerned with a situation that is different than that of applicant's in that in applicant's invention, a visitor does not know the address of the recipient. Examiner notes whether a person knows or doesn't know the recipient or address of the recipient is not part of an electronic system, and is not patentable matter. Oshima and Ewing meet all of the structural and method limitations presented in the claims as discussed above.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Kyle whose telephone number is 703-305-3614. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

mk


Lynne Browne
Supervisory Patent Examiner
Technology Center 3600